



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,178	11/03/2003	Cristina Manu	03797.00622	3590

28319 7590 01/24/2006

BANNER & WITCOFF LTD.,
ATTORNEYS FOR MICROSOFT
1001 G STREET, N.W.
Suite 1100
WASHINGTON, DC 20001-4597

EXAMINER

TSAI, CAROL S W

ART UNIT

PAPER NUMBER

2857

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,178

Applicant(s)

MANU ET AL.

Examiner

Carol S. Tsai

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/3/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

2. In view of the "BRIEF ON APPEAL" filed on December 31, 2005, PROSECUTION IS HEREBY REOPENED. The Office Action with the new ground(s) of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the body of the claim does not appear to support the preamble. The preamble says it is a method of “generating a list...”, but the list is never generated.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In claim 1, the body of the claim does not appear to support the preamble. The preamble says it is a method of “generating a list...”, but the list is never generated. This leads to a problem under 101, in that the method does not produce a tangible result. Selecting is nothing more than a thought or a computation within a processor, rather than a real world result.

NOTE: If there was, for example, an additional step of generating the list of parameter value combinations to test from the selected combinations, that would be a tangible result and would support the preamble, resolving the 112, 2nd issue and 101 issue.

Allowable Subject Matter

6. Claims 16 and 17 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

U.S. Publication 2005/0210085 to Bessiere is the reference closest to the claimed invention. Bessiere discloses selecting according to a predefined selection criterion one of the combinations of values of the specific parameters based on the representation of the previously

Art Unit: 2857

constructed tree-shaped probability distribution. However, Bessiere does not teach a computer system having a graphical user interface including a display and a user selection device, a method of testing a software module with parameter combinations, comprising: (a) displaying in a first region of the display a list of parameter combinations; (b) displaying in a second region of the display an input icon; (c) receiving an indication from a user to drag at least one of the parameter combinations to the input icon; and (d) in response to (c) displaying in a third region of the display an output of the software module; and including all of the other limitations in the respective independent claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cebula et al. disclose a system, method, and computer program product for software testing, including analyzing the source code under test to generate a scan file, including a map of the source code under test and a tree structure for the source code under test; generating a stub file for the source code under test based on the scan file; generating a driver test script file based on the scan file and the stub file; generating a test driver based on the driver test script file; and running the test driver on the source code under test to generate a results file for summarizing the results of the software testing.

Woodcock et al. disclose an improved method of characterizing the potential financial benefit to a facility such as a nuclear power plant that would result from various groups of possible activities includes determining a number of goals for the facility, identifying groups of activities that could effect achievement of the goal and, for each group of activities, determining

Art Unit: 2857

a probability distribution on net present savings corresponding with implementation of the group of activities.

Cifra et al. disclose a system and method for automatically (i.e., programmatically) generating a computer program based on program information, wherein the program includes a graphical user interface (GUI) for specifying input values to or viewing output values from the program.

Williams et al. disclose a system and method for dynamically determining a plurality of possible or valid parameter values and automatically including one of the parameter values in a software program.

Cuo et al. disclose a method (and structure) of calculating an optimal mix of inputs for a problem having a plurality of possible scenarios, includes providing data for parameters for each of the scenarios, wherein the data includes a probability of each of the possible scenarios.

Yang et al. disclose a method and system for evaluating structural defects in metals.

Hinker et al. discloses a system that automatically generates Fortran 90 interfaces to Fortran 77 code.

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol S. W. Tsai whose telephone number is (571) 272-2224. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

Art Unit: 2857

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571) 272-2216. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

cswt
January 20, 2006
Art Unit 2857



CAROL S.W. TSAI
PRIMARY EXAMINER